APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,722	05/23/2001	John R. Martin	10527US16	2165

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EXAMINER
DIXON, THOMAS A

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 May 2001_ .

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _16-26_ is/are pending in the application.

　4a) Of the above claim(s) _1-15_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _16-26_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

　If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____ .

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

　a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1.   Applicant is requested to furnish IDS referred to in the preliminary amendment.

Double Patenting

2.   A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

3.   Claims 16-26 are rejected under 35 U.S.C. 101 as claiming the same invention

as that of claims 1-11 of prior U.S. Patent No. 6,397,189. This is a double patenting

rejection.

Claim Objections

4.   Claim 17 is objected to because of the following informalities:

line 5, the first occurrence of the word "song" is confusing.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 16-18, 20, 22-23, 25-26 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Castille (5,497,502) in view of Cohen (4,949,187).

> As per Claim 16.
> Castille ('502) discloses:
> a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;
> a data storage unit for storing, see column 5, lines 28-29;
> a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);
> selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15);
> at least one audio speaker, see figure 1 (17);
> a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10;
> a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker, see figure 1 (47);
> causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;
> causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and
> Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit.
> Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1-6.
> Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

> As per Claim 17.

Castille ('502) does not specifically disclose:

instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor.

Cohen ('187) teaches instructions causing the processor to respond to control the information shown on the display to include the updated library of songs, see column 5, lines 2-7, instructions causing the processor to store song usage data generated upon the playing of a song, and wherein the communications interface includes a transmitter for transmitting song usage data under the control of the processor, see column 4, lines 26-29 for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs and store song usage data as taught by Cohen ('187) for the benefit of providing users with convenient access to videos and ensure proper royalty payments.

As per Claim 18.

Castille ('502) further discloses transmitting images and associated digital song data, see column 1, lines 17-29.

As per Claim 20.

Castille ('502) further discloses communication interface is telecommunication and further the storage of file identity data, see column 4, line 62 – column 5, line 29.

As per Claim 22.

Castille ('502) discloses:

a plurality of computer jukeboxes, capable of playing songs selected by users of the jukebox from a library of songs that have been digitally compressed and stored in the computer jukebox, see figure 1 (15) and column 4, lines 1-11;

a communication interface for receiving the compressed digital song data and the song identity data, see figure 1 (13) and column 5, lines 1-5;

a data storage unit for storing, see column 5, lines 28-29;

a display for showing, to a prospective user of the computer jukebox, information identifying the songs for which digital song data is stored in the storage data unit and that is based on song identity data, see column 5, lines 1-25, and figure 1 (15);

selection keys responsive to a selection of a song to be played on the computer jukebox from the song identity information displayed on the display, the selection keys including a signal output representing activation of the selection keys, see column 5, lines 1-25 and figure 1 (15);

at least one audio speaker, see figure 1 (17);

a processor connected to a memory, the memory including a decompression algorithm for decompressing compressed digital song data, see column 5, lines 6-10;

a digital to analog converter coupled between the processor and the audio speaker to convert digital song data to an analog signal coupled to the speaker, see figure 1 (47);

causing the processor, in response to the signal output, to access and process compressed digital song data received from the data storage unit so that the accessed compressed digital song data corresponds to the song selected by the selection keys, see column 5, lines 1-5;

causing the processor to decompress the accessed compressed digital song data and send the decompressed digital song data to the digital to analog computer so that the song selected is played on the computer jukebox as a result of the corresponding stored compressed song digital data being decompressed and converted by the processor and the digital to analog converter, see column 5, lines 6-10; and

Castille ('502) discloses the storage of software, see column 5, lines 28-29, but does not specifically disclose the storage of the received compressed digital song data and the received song identity data in the data storage unit and a management station for updating the library of songs in each of the plurality of jukeboxes.

Cohen ('187) teaches transmitting audio disks and updating an inventory list in a remote computer, see column 5, lines 1–6, from a management station, see figure 4 (36) with communication interface (58), processor (36), storing digital song data (12, 14, 16, 18, 20, 22, 24, 26), data compressor (58) and transmitter (58) and column 1, lines 46-61.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to cause the processor to respond to compressed digital song data and to song identity data which may be received by the communication interface of the computer jukebox from a management station, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit, as taught by Cohen ('187) to create an updated library of songs stored in the computer jukebox.

As per Claims 23.
Castille ('502) further discloses bi-directional communications, see figure 1 (2).

As per Claims 25.
Castille ('502) does not specifically disclose the display of the updated list.

Cohen ('187) teaches instructions causing the processor to display the updated library of songs, see column 5, lines 2-7 for the benefit of providing users with convenient access to videos.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to display the updated list of songs as taught by Cohen ('187) for the benefit of providing users with convenient access to videos.

As per Claims 26.
Castille ('502) does not specifically disclose the storage of usage data.

Cohen ('187) teaches instructions causing the processor to store usage data, see column 4, lines 26-29 for the benefit of ensuring proper royalty payments.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to store usage data as taught by Cohen ('187) for the benefit of ensuring proper royalty payments.

6.   Claims 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Castille (5,497,502) in view of Cohen (4,949,187) in view of Official Notice.

As per Claim 21.

Castille ('502) does not specifically disclose the display is at least 14 inches in diagonal measure.

Official Notice is taken that computer monitors of varying sizes are well known in the computer arts as a matter of user choice.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to utilize a display of at least 14 inches in diagonal measure for reasons of user choice.

As per Claim 24.

Castille ('502) further discloses communications link, see figure 1 (2).

Castille ('502) does not specifically disclose the management station is portable.

Official Notice is taken that it is well known to make portable as a design choice. This limitation is seen to be will not distinguish the invention from the prior art in terms of patentability, see In re Lindberg, 93 USPQ 23, 25; 194 F2d 732 (CCPA 1952).

Therefore it would have been obvious to one of ordinary skill at the time the invention was made to make the management station portable as a design choice.

Prior Art Made of Record

7.   The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

Muncaster (GB 2 057 174) is the closest foreign art, but does not disclose a user attract mode wherein song associated images are shown.

Audiocomp Technical Announcement is the closest non-patent literature, but is not applicable datewise.

Allowable Subject Matter

8.   Claim 19 is objected to as being dependent upon a rejected base claim, but

would be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims and overcoming the 101 rejection.

As per Claim 19.
Castille ('502) does not disclose a user attract mode wherein song associated
images are shown.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Thomas A. Dixon whose telephone number is (703)

305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 305-7687

for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 308-

1113.

Thomas A. Dixon
Examiner
Art Unit 3629

August 20, 2002